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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/870,762	06/06/1997	BRADFORD J. DUFT	226/104US	7328
44638	7590	01/07/2009	EXAMINER	
Intellectual Property Department Amylin Pharmaceuticals, Inc. 9360 Towne Centre Drive San Diego, CA 92121			DEVI, SARVAMANGALA J N	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADFORD J. DUFT
and
ORVILLE G. KOLTERMAN

Application No. 08/870,762
Technology Center 1600

Mailed: January 6, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on December 23, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed October 29, 2008 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007)* for details.

Specifically, the Examiner's Answer sets forth a rejection of claims 1, 2, 4-7 and 9-16 as being rejected under 35 U.S.C. § 112, first paragraph (Scope of Enablement) [page 3]; whereas the last Office action (Advisory Action mailed April 30, 2008) finds that claims 1-7 and 9-17 are rejected under 35 U.S.C. § 112, first paragraph (Scope of Enablement) [page 11]. Clarification regarding the status of claims 3 and 17 is required.

**EXAMINER'S ANSWER, MISSING CERTIFIED
TRANSLATION**

The Examiner relied on the foreign reference by Tsanev (*Vutr. Boles 23: 12-17, 1994, abstract*) in rejecting the claims. A full certified English

translation of the above-noted foreign reference is not of record in the Image File Wrapper (IFW).

When an Examiner relies on a document “in a language other than English, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added). *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) §1207.02. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added).

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to provide a PTOL-90 which clarifies the status of claim 3 and 17 in the 35 U.S.C. § 112, first paragraph (Scope of Enablement) rejection;
- 2) to obtain a full certified English language translation of the above-noted foreign reference;
- 3) to complete the IFW by having the translation obtained scanned into the IFW file;
- 4) to provide a copy of the translation obtained to Appellants; and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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